# UNITED STATES PATENT AND TRADEMARK OFFICE

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/176,077 | 10/20/1998 | ROBIN ARTHUR GREEN | CA9-98-038 | 7754 |

25259     7590     10/03/2003

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| ART UNIT | PAPER NUMBER |
|---|---|
| 2176 | |

DATE MAILED: 10/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)☒ Responsive to communication(s) filed on _22 July 2003_ .

2a)☐ This action is **FINAL**.     2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)☒ Claim(s) _1-8,10,11 and 13-41_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-8,10,11 and 13-41_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

## Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____ .

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

| | |
|---|---|
| 1)☐ Notice of References Cited (PTO-892) | 4)☐ Interview Summary (PTO-413) Paper No(s). _____ . |
| 2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5)☐ Notice of Informal Patent Application (PTO-152) |
| 3)☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6)☐ Other: . |

## DETAILED ACTION

1.      This action is responsive to communications: amendment filed July 22, 2003, to the original application

filed **October 20, 1998**.

2.      The rejection of claims 1-8, 10-11, 13-24, 33-41 under 35 U.S.C. 112, second paragraph, as being

indefinite, has been withdrawn as necessitated by amendment.

3.      Claims 25-32 remain rejected under 35 U.S.C. 112, second paragraph, as being indefinite.

4.      The rejection of claims 1, 10, 16-20, 33, 40 under 35 U.S.C. 103(a) as being unpatentable over

Gramlich, has been withdrawn as necessitated by amendment.

5.      The rejection of claims 2-8, 11, 13-15, 34-38 under 35 U.S.C. 103(a) as being unpatentable over

Gramlich, and Tran, has been withdrawn as necessitated by amendment.

6.      The rejection of claims 21-24, 39, 41 under 35 U.S.C. 103(a) as being unpatentable over Gramlich,

Tran, and Merritt, has been withdrawn as necessitated by amendment.

7.      Claims 25-32 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Gramlich, Tran, and

Merritt.

8.      Claims 1-8, 10-11, 13-41 are pending. Claims 1, 21, 25, 29, 33, and 39 are independent claims.

### *Continued Examination Under 37 CFR 1.114*

9.      A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e),

was filed in this application after final rejection.  Since this application is eligible for continued examination

under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous

Office action has been withdrawn pursuant to 37 CFR 1.114.  Applicant's submission filed on 7/22/2003 has

been entered.

*Claim Rejections - 35 USC § 112*

10.    The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11.    **Claims 25-32 remain rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

**In regard to independent claims 25, 29,** the phrase *"...to conventional browser requests"* is vague and indefinite. The examiner cannot establish the metes and bounds of the claimed limitations because it is unclear how the word "conventional" is to be defined within the instant claims. Said phrase in question is subjective, and can possibly change with time, therefore its meaning is unclear.

The examiner notes that confusion may have resulted because the instant quoted limitation (*"...to conventional browser requests"* does not entirely match the quote presented in the original rejection (*"...using conventional browser requests"*). However, the relevant claims were/are rejected based substantially on the word *"conventional"* as being indefinite.

**In regard to dependent claims 26-28, 30-32,** claims 26-28, 30-32 are rejected for fully incorporating the deficiencies of their respective base claims (see above).

*Examiner's Note*

12.    The following set of rejections are based upon a possible interpretation of the phrase *"...to conventional browser requests"* to mean requests from a browser.

*Claim Rejections - 35 USC § 103*

13.     **The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness**

**rejections set forth in this Office action:**

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

14.     **Claims 1, 10, 16-20, 33, 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over**

**Gramlich, U.S. Patent No. 5,826,025 issued October 1998, in view of Day et al. (hereinafter Day), U.S.**

**Patent No. 6,243,722 issued June 2001 (cited in a previous action).**

          **In regard to independent claim 1**, Gramlich teaches an annotation overlay system of storing and

managing a set of "annotation overlays" indicative of commentary associated with a requested source document

file (Gramlich Abstract, column 2 lines 65-67 to column 3 lines 1-2, also column 3 lines 9-13; compare with

claim 1 preamble *"for storing and managing a set of comments associated with a source file, comprising"*).

          Gramlich teaches a Web browser which is used to request source files (source URLs) via a source

message (Gramlich Figure 1, also column 2 lines 65-67 to column 3 lines 1-2, column 4 lines 42-46, 61-64).

Although the original document is requested using unmodified protocols (i.e. HTTP), Gramlich does not

specifically teach that the requests to the overlay sources (Figure 1 item 116) are sent using unmodified

protocols. However, Day teaches a comment review system whereby comments are entered and stored

separately from the original document, said comments sent utilizing a typical browser using typical protocols

(Day, Abstract, Figure 6, 7, column 4 lines 18-25, column 5 lines 45-49, column 7 lines 22-38, column 8 lines

53-60; compare with claim 1 *"means for requesting the source file using unmodified standard messaging*

*protocols"*). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply

Day's unmodified browser's use of sending (source) comments, to Gramlich's sending of source data to the

annotation proxy (i.e. Gramlich Figure 1 items 114, 116), providing Gramlich the benefit of capitalizing on the ubiquity of (typical) web browsers (see Day column 7 lines 27-28).

Gramlich does not specifically teach a "*file review system*", as claimed. However, Gramlich teaches that it is important that Web users be able to comment on the content of a Web document, as well as view the commentary of others, providing the claimed equivalent of a file review system (Gramlich column 1 lines 60-67; compare with claim 1 preamble "*A file review system...*"). It would have been obvious to one of ordinary skill in the art at the time of the invention to interpret Gramlich's system to be used for document review purposes, providing the benefit of critical review of published documents.

Gramlich teaches retrieving source documents in a Web browser (indicative of an HTML file) (Gramlich Abstract, column 3 lines 65-67, column 4 lines 43-50; compare with claim 1 "*means for accepting data from the source file....source file as a markup file,*").

Gramlich teaches annotation overlay groups encapsulating annotation overlays associated with a source document file (Gramlich column 3 lines 9-13, column 11 lines 54-61; compare with claim 1 "*means for creating a comment file containing data....comments associated with the source file*").

Gramlich teaches input and acceptance of new annotation overlays directly to one or more overlay groups. Gramlich also teaches a grouped set of overlays associated with a document. The overlay groups are updated with new contributions accordingly (Gramlich column 7 lines 35-45, column 8 lines 40-50; compare with claim 1 "*means for accepting new comments for inclusion....to correspond to the complete set of comments*").

Gramlich teaches a source document in a Web browser (indicative of an HTML file) (Gramlich Abstract, column 3 lines 65-67, column 4 lines 43-50), as well as associated annotation overlays, said overlays also written in HTML (Gramlich column 8 lines 35-40). Gramlich also teaches an annotation overly proxy (AOP), which dynamically combines a source document with associated annotation overlays, the resulting merged document can be shown via browser by directly displaying the inserted overlay text at the insertion point within the source document (Gramlich column 11 lines 25-29, column 12 lines 34-36, column 13 lines 8-

16, also Figure 5; compare with claim 1 *"means for generating a hypertext document from the markup file....the set of comments associated with the source file"*).

Gramlich teaches display of a merged hypertext document via a browser (Gramlich Abstract, column 3 lines 17-22 column 4 lines 43-47; compare with claim 1 *"means for communicating the hypertext document to a browser for display."*).

**In regard to dependent claim 10,** Gramlich teaches addition of an HTML tag indicative of a hypertext link at a defined subsection of the source HTML document, said hyperlink referencing an overlay file from an overlay group (Gramlich column 13 lines 1-10; compare with claim 10).

**In regard to dependent claim 16,** Gramlich teaches a magazine model, whereby authors submit annotations to an editor for incorporation into overlay groups, said groups restricted to subscribed members (Gramlich column 8 lines 46-54; compare with claim 16).

**In regard to dependent claim 17,** the limitation of defined cutoff dates and restricting comments on dates past said cutoff date, would have been obvious to one of ordinary skill in the art at the time of the invention, in view of Gramlich, because Gramlich teaches selling subscriptions to overlay groups (in a magazine model), suggesting the use of cutoff dates and deadlines for article submission and user/author inclusion (Gramlich column 8 lines 40-54; compare with claim 17), providing a user of Gramlich the benefit of providing a periodical magazine structure.

**In regard to dependent claim 18,** Gramlich teaches authors contributing annotation overlays associated with sequenced insertion positions within a source document (Gramlich column 3 lines 9-13, column 8 lines 40-54, column 13 lines 1-9; compare with claim 18).

In regard to dependent claims 19-20, Gramlich teaches icons as hypertext links within a merged document (Gramlich column 13 lines 8-13; compare with claim 19).

The limitation of accumulating/displaying statistics, would have been obvious to one of ordinary skill in the art at the time of the invention, in view of Gramlich, because Gramlich teaches selling user subscriptions to overlay groups (in a magazine model), suggesting the use of user/author statistics (i.e. subscriber lists) (Gramlich column 8 lines 40-54; compare with claim 20), providing a user of Gramlich the benefit of providing statistics for a periodical magazine structure.

In regard to independent claim 33, claim 33 incorporates substantially similar subject matter as claimed in claim 1, and is rejected along the same rationale.

In regard to dependent claim 40, claim 40 reflects the computer program product comprising computer executable instructions for performing the methods as claimed in claim 33, and is rejected along the same rationale.

12.     Claims 2-8, 11, 13-15, 34-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gramlich, and Day as applied to claims 1 and 33 above, and further in view of Tran, U.S. Patent No. 6,054,990 issued April 2000.

In regard to dependent claim 2, Gramlich does not specifically teach representation of a source file as a linked list. However, Tran teaches insertion of annotation text into linked list objects (Tran column 15 lines 30-39; compare with claim 2). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Tran to Gramlich, because of Tran's taught advantage of linked lists, providing a user of Gramlich with a way to dynamically store files.

**In regard to dependent claims 3-6** Gramlich teaches merging of HTML based overlays with HTML source documents (see rejection of claims 1 and 2, above), as well as displaying an icon (symbol) or hyperlink cue at the overlay insertion point within a merged document, reflective of an annotation insertion point. Gramlich also teaches addition of HTML tags within the merged document, and the hyperlink cue (tag) at said insertion point causes the overlay to appear subsequent to hyperlink activation (Gramlich column 12 lines 25-35; compare with claims 3-6).

**In regard to dependent claims 7, 8,** Gramlich does not specifically teach representation of a source file as a linked list. However, Tran teaches insertion of annotation text into linked list objects (Tran column 15 lines 30-39). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Tran to Gramlich, because of Tran's taught advantage of linked lists, providing a user of Gramlich with a way to dynamically store and manipulate objects.

In addition, Gramlich teaches insertion of HTML tags at the end of each sentence, and deletion of a pattern or range of words surrounding a pattern (Gramlich column 9 lines 20-25, column 13 lines 1-9). Compare the above with claims 7, 8.

**In regard to dependent claim 11,** Gramlich teaches HTML comprising various definable tags (Gramlich Abstract, column 3 lines 65-67, column 4 lines 43-50). Gramlich also teaches inserting information into a merged document at a location defined in an action field, as well as an icon at the point of insertion (Gramlich column 12 lines 32-42). Compare the above with claim 11.

**In regard to dependent claims 13-15,** Gramlich teaches a subset of annotation overlays associated with a document, said annotations referenced by patterns, said annotations also referenced by authors and content (Gramlich column 7 lines 35-40, column 8 lines 40-51, 54-67; compare with claims 13-15).

**In regard to dependent claims 34, 35, 36, 37, 38**, claims 34, 35, 36, 37, 38 incorporate substantially

similar subject matter as claimed in claims 2, 3, 4, 5, 6, respectively, and are rejected along the same rationale.

13.     **Claims 21-24, 39, 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gramlich, in**

**view of Day, and in further view of Tran, and in view of Merritt et al. (hereinafter Merritt), U.S. Patent**

**No. 6,041,335 issued March 2000.**

**In regard to independent claim 21**, Gramlich teaches:

- a Web based annotation overlay system of storing and managing a set of "annotation overlays"

indicative of commentary associated with a requested source document file (Gramlich Abstract, column 2 lines

65-67 to column 3 lines 1-2, also column 3 lines 9-13 compare with claim 21 preamble "*A web-based....with*

*one or more webs of source file, comprising*").

Gramlich does not specifically teach a "*file review system*", as claimed. However, Gramlich teaches that

it is important that Web users be able to comment on the content of a Web document, as well as view the

commentary of others, providing the claimed equivalent of a file review system (Gramlich column 1 lines 60-

67; compare with claim 21 preamble "*A file review system...*"). It would have been obvious to one of ordinary

skill in the art at the time of the invention to interpret Gramlich's system to be used for document review

purposes, providing the benefit of critical review of published documents:

- retrieving source documents in a Web browser (indicative of an HTML file), as well as HTML based

annotation overlays associated with said source documents (Gramlich Abstract, column 3 lines 65-67, column 4

lines 43-50, column 8 lines 35-40; compare with claim 21 "*a parser to parse....associated with one or more*

*comments.*").

- Gramlich does not specifically teach representation of a source file as a linked list. However, Tran

teaches insertion of annotation text into linked list objects (Tran column 15 lines 30-39; compare with claim 21

"*a linked list of objects*"). It would have been obvious to one of ordinary skill in the art at the time of the

invention to apply Tran to Day, because of Tran's taught advantage of linked lists, providing a user of Day with the benefit of dynamically storing files.

- annotation overlay groups encapsulating annotation overlays (files) associated with a source document file (Gramlich column 3 lines 9-13, column 11 lines 54-61; compare with claim 21 "*a set of comment files....updating the associated comment file*").

- input and acceptance of new annotation overlays directly to one or more overlay groups. Gramlich also teaches a grouped set of overlays associated with a document. The overlay groups are updated with new contributions accordingly, the invention utilizing CGI (Gramlich column 5 lines 12-15, column 7 lines 35-45, column 8 lines 40-50; compare with claim 21 "*common gateway interface program....updating the associated comment file*", and "*common gateway interface program code means for generating a hypertext document....the reviewer-selected source files*").

Gramlich teaches a Web browser which is used to request source files (source URLs) via a source message (Gramlich Figure 1, also column 2 lines 65-67 to column 3 lines 1-2, column 4 lines 42-46, 61-64). Although the original document is requested using unmodified protocols (i.e. HTTP), Gramlich does not specifically teach that the requests to the overlay sources (Figure 1 item 116) are sent using unmodified protocols. However, Day teaches a comment review system whereby comments are entered and stored separately from the original document, said comments sent utilizing a typical browser using typical protocols (Day, Abstract, Figure 6, 7, column 4 lines 18-25, column 5 lines 45-49, column 7 lines 22-38, column 8 lines 53-60; compare with claim 21 "*wherein said source file is selected using unmodified standard messaging protocols*"). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Day's unmodified browser's use of sending (source) comments, to Gramlich's sending of source data to the annotation proxy (i.e. Gramlich Figure 1 items 114, 116), providing Gramlich the benefit of capitalizing on the ubiquity of (typical) web browsers (see Day column 7 lines 27-28).

- a source document in a Web browser (indicative of an HTML file) (Gramlich Abstract, column 3 lines 65-67, column 4 lines 43-50), as well as associated annotation overlays, said overlays also written in HTML (Gramlich column 8 lines 35-40). Gramlich also teaches an annotation overly proxy (AOP), which dynamically

combines a source document with associated annotation overlays, the resulting merged document can be shown

via browser by directly displaying the inserted overlay text at the insertion point within the source document, as

well as marking insertion points with hypertext cues (Gramlich column 11 lines 25-29, column 12 lines 30-36,

column 13 lines 8-16, also Figure 5; compare with claim 21 "*the hypertext document including portions....by the*

*associated comment display objects*", and "*the hypertext document selectively including hypertext links...*").

    - input and acceptance of new annotation overlays directly to one or more overlay groups. Gramlich also

teaches a grouped set of overlays associated with a document. The overlay groups are updated with new

contributions accordingly, the invention utilizing CGI (Gramlich column 5 lines 12-15, column 7 lines 35-45,

column 8 lines 40-50).

    - Gramlich does not specifically teach providing reviewers with forms for entry of comments. However,

Merritt teaches a hypertext document passed to various users, said document also incorporating comments

associated with positional icons, with reviewers commenting in a sequential fashion (Merritt Figure 3, also

column 5 lines 1-6, 64-67, column 6 lines 1-17; compare with claim 21 "*.... providing reviewers with forms for*

*accepting new comments*"). It would have been obvious to one of ordinary skill in the art at the time of the

invention to apply Merritt to Gramlich, because of Merritt's taught advantage of including comments within a

document, providing users of Gramlich the benefit of inspecting and commenting upon previous comments

made to a document.

    - display of a merged hypertext document via a browser (Gramlich Abstract, column 3 lines 17-22

column 4 lines 43-47; compare with claim 21 "*means for communicating the hypertext document to a browser*

*for display.*").


    **In regard to dependent claim 22,** Gramlich teaches merging of HTML based overlays with HTML

source documents (see rejection of claims 1 and 2, above), as well as displaying an icon (symbol) or hyperlink

cue at the overlay insertion point within a merged document, reflective of an annotation insertion point.

Gramlich also teaches addition of HTML tags within the merged document, and the hyperlink cue (tag) at said

insertion point causes the overlay to appear subsequent to hyperlink activation  (Gramlich column 12 lines 25-35; compare with claim 22).

**In regard to dependent claims 23, 24,** Gramlich teaches adding HTML formatted content to a merged file, as well as HTML based source and overlay files, said HTML containing various tags and insertion identifiers (Gramlich column 6 lines 15-23; compare with claims 23, 24). Gramlich teaches HTML comprising various definable tags (Gramlich Abstract, column 3 lines 65-67, column 4 lines 43-50). Gramlich also teaches inserting information into a merged document at a location defined in an action field, as well as an icon at the point of insertion (Gramlich column 12 lines 32-42). Compare the above with claims 23, 24. The use of a linked list of objects has been previously discussed.

**In regard to independent claim 39,** Gramlich teaches:

- a Web based annotation overlay system of storing and managing a set of "annotation overlays" indicative of commentary associated with a requested source document file (Gramlich Abstract, column 2 lines 65-67  to column 3 lines 1-2, also column 3 lines 9-13 compare with claim 39 preamble *"A method for storing and managing comments on a web-based....with one or more webs of source file, comprising"*).

- the limitation of a *"file review system"* would have been obvious to one of ordinary skill in the art at the time of the invention, in view of Gramlich, because Gramlich teaches that it is important that Web users be able to comment on the content of a Web document, as well as view the commentary of others (Gramlich column 1 lines 60-67; compare with claim 39 preamble *"file review system... "*), suggesting Gramlich's system can be used for document review purposes, providing the benefit of critical review of published documents.

- retrieving source documents in a Web browser (indicative of an HTML file), as well as HTML based annotation overlays associated with said source documents (Gramlich Abstract, column 3 lines 65-67, column 4 lines 43-50, column 8 lines 35-40; compare with claim 39 *"parsing a selected....associated with one or more comments."*).

- Gramlich does not specifically teach representation of a source file as a linked list. However, Tran teaches insertion of annotation text into linked list objects (Tran column 15 lines 30-39; compare with claim 39 "*a linked list of objects*"). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Tran to Gramlich, because of Tran's taught advantage of linked lists, providing a user of Gramlich with the benefit of dynamically storing files.

- annotation overlay groups encapsulating annotation overlays (files) associated with a source document file (Gramlich column 3 lines 9-13, column 11 lines 54-61; compare with claim 21 "*a set of comment files....updating the associated comment file*").

- input and acceptance of new annotation overlays directly to one or more overlay groups. Gramlich also teaches a grouped set of overlays associated with a document. The overlay groups are updated with new contributions accordingly, the invention utilizing CGI (Gramlich column 5 lines 12-15, column 7 lines 35-45, column 8 lines 40-50; compare with claim 39 "*on review request....with one of the set of source files*", and "*common gateway interface program code means for generating a hypertext document....the reviewer-selected source files*").

- a source document in a Web browser (indicative of an HTML file) (Gramlich Abstract, column 3 lines 65-67, column 4 lines 43-50), as well as associated annotation overlays, said overlays also written in HTML (Gramlich column 8 lines 35-40). Gramlich also teaches an annotation overly proxy (AOP), which dynamically combines a source document with associated annotation overlays, the resulting merged document can be shown via browser by directly displaying the inserted overlay text at the insertion point within the source document, as well as marking insertion points with hypertext cues (Gramlich column 11 lines 25-29, column 12 lines 30-36, column 13 lines 8-16, also Figure 5; compare with claim 39 "*dynamically generating a hypertext document....reviewer-selected source file*", and "*the hypertext document including portions....the associated comment display object*", and "*the hypertext document selectively including hypertext links...*").

Gramlich teaches a Web browser which is used to request source files (source URLs) via a source message (Gramlich Figure 1, also column 2 lines 65-67 to column 3 lines 1-2, column 4 lines 42-46, 61-64). Although the original document is requested using unmodified protocols (i.e. HTTP), Gramlich does not

specifically teach that the requests to the overlay sources (Figure 1 item 116) are sent using unmodified protocols. However, Day teaches a comment review system whereby comments are entered and stored separately from the original document, said comments sent utilizing a typical browser using typical protocols (Day, Abstract, Figure 6, 7, column 4 lines 18-25, column 5 lines 45-49, column 7 lines 22-38, column 8 lines 53-60; compare with claim 39 *"wherein said source file is selected responsive to unmodified standard messaging protocols"*). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Day's unmodified browser's use of sending (source) comments, to Gramlich's sending of source data to the annotation proxy (i.e. Gramlich Figure 1 items 114, 116), providing Gramlich the benefit of capitalizing on the ubiquity of (typical) web browsers (see Day column 7 lines 27-28).

- Gramlich does not specifically teach providing reviewers with forms for entry of comments. However, Merritt teaches a hypertext document passed to various users, said document also incorporating comments associated with positional icons, with reviewers commenting in a sequential fashion (Merritt Figure 3, also column 5 lines 1-6, 64-67, column 6 lines 1-17; compare with claim 39 *".... providing reviewers with forms for accepting new comments"*). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Merritt to Gramlich, because of Merritt's taught advantage of including comments within a document, providing users of Gramlich the benefit of inspecting and commenting upon previous comments made to a document.

- input and acceptance of new annotation overlays directly to one or more overlay groups. Gramlich also teaches a grouped set of overlays associated with a document. The overlay groups are updated with new contributions accordingly, the invention utilizing CGI (Gramlich column 5 lines 12-15, column 7 lines 35-45, column 8 lines 40-50; compare with claim 39 *"the hypertext document....for accepting new comments"*).

- display of a merged hypertext document via a browser (Gramlich Abstract, column 3 lines 17-22 column 4 lines 43-47; compare with claim 39 *"communicating the hypertext document to a browser for display."*).

**In regard to dependent claim 41**, claim 41 reflects the computer program product comprising computer executable instructions for performing the methods as claimed in claim 39, and is rejected along the same rationale.

14.     **Claims 25-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gramlich, U.S. Patent No. 5,826,025 issued October 1998, in view of Tran, U.S. Patent No. 6,054,990 issued April 2000, and further in view of Merritt et al. (hereinafter Merritt), U.S. Patent No. 6,041,335 issued March 2000.**

**In regard to independent claim 25**, claim 25 reflects the article of manufacture comprising computer executable instructions for performing the methods of the system as claimed in claim 21, and in further view of the following, is rejected along the same rationale.

Gramlich teaches a Web browser which is used to request source files (source URLs) via a source message (Gramlich Figure 1, also column 2 lines 65-67 to column 3 lines 1-2, column 4 lines 42-46, 61-64; compare with claim 25 *"conventional browser requests"*).

**In regard to dependent claims 26, 27, 28**, claims 26, 27, 28 reflect the article of manufacture comprising computer executable instructions for performing the methods of the system as claimed in claims 22, 23, 24, and are rejected along the same rationale.

**In regard to independent claim 29**, claim 29 reflects the computer program product comprising computer executable instructions for performing the methods of the system as claimed in claim 21, and in further view of the following, is rejected along the same rationale.

Gramlich teaches a Web browser which is used to request source files (source URLs) via a source message (Gramlich Figure 1, also column 2 lines 65-67 to column 3 lines 1-2, column 4 lines 42-46, 61-64; compare with claim 29 *"conventional browser requests"*).

**In regard to dependent claims 30, 31, 32,** claims 30, 31, 32 reflect the computer program product

comprising computer executable instructions for performing the methods of the system as claimed in claims 22,

23, 24, and are rejected along the same rationale.


### *Response to Arguments*

15.     Applicant's arguments filed July 22, 2003 have been fully and carefully considered, but they are not

persuasive.

Applicant argues on page 21 of the amendment that Gramlich requires a side application (a new or

modified browser) to be installed, in contrast to Applicant's claimed invention comprising the use of

conventional browser requests (i.e. unmodified protocols). Since Applicant's arguments are substantially

directed to amended subject matter, said arguments are currently moot in view of the new grounds of rejection.


### *Conclusion*

16.     Any inquiry concerning this communication or earlier communications from the examiner

should be directed to William Bashore whose telephone number is **(703) 308-5807**. The examiner can

normally be reached on Monday through Friday from 11:30 AM to 8:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor,

Joseph Feild, can be reached on **(703) 305-9792**.

Any inquiry of a general nature or relating to the status of this application should be directed to the

Group receptionist whose telephone number is **(703) 305-3900**.

17.    **Any response to this action should be mailed to:**

        Commissioner of Patents and Trademarks
        Washington, D.C. 20231

    **or faxed to:**

        **(703) 746-7239**  (for formal communications intended for entry)

    **or:**

        **(703) 746-7240**  (for informal or draft communications, please label
        "PROPOSED" or "DRAFT")

    **or:**

        **(703) 746-7238** (for after-final communications)

**Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,
Arlington, VA, Fourth Floor (Receptionist).**

William L. Bashore
July 22, 2003

**SANJIV SHAH
PRIMARY EXAMINER**